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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/707,079	11/06/2000	David Hose	42365-00380	9121
33623	7590	01/15/2004	EXAMINER	
MARSH FISCHMANN & BREYFOGLE LLP/OPENWAVE SYSTEM INC. 3151 SOUTH VAUGHN WAY SUITE 411 AURORA, CO 80014			MOORE, JAMES K	
			ART UNIT	PAPER NUMBER
			2686	20

DATE MAILED: 01/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/707,079

Applicant(s)

HOSE, DAVID

Examiner

James K Moore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 76-87 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 76-81 is/are allowed.
- 6) ☒ Claim(s) 82-87 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Arguments***

1. Applicant's arguments with respect to claims 82-87 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 102***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 82 and 84-86 are rejected under 35 U.S.C. 102(e) as being anticipated by Watters et al. (U.S. Patent No. 6,070,083).

Regarding claim 82, Watters discloses a method for providing location based services in a wireless network. The method comprises receiving, on a network platform (location server/location service server) in communication with a subscriber using a mobile unit via an air interface, a service request requesting service provider information regarding the location based services. See col. 2, lines 32-53 and col. 3, lines 34-37. The service request includes service type information identifying a type of services for which the service provider information is requested. See col. 3, lines 40-42. The method also comprises obtaining, on the network platform, location information regarding a location of the mobile unit determined using a network assisted location finding technology. The technology provides location information regarding the mobile unit based in part on a position of the mobile unit in relation to a known location of a

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stationary ground based network device (base station) in communication with the mobile unit. See col. 1, lines 40-46 and col. 3, lines 42-45. The method also comprises identifying, on the network platform based on the service type information and the location information, a number of candidate service providers including first and second service providers from a database of service providers and further identifying first and second service provider information associated with the first and second service providers. See col. 3, lines 49-55.

The method further comprises storing selection information (e.g., types of ethnic restaurants) relating to selecting from the number of candidate service providers a subset of service providers less than the whole of the number of candidate service providers for use in presenting service provider information to a subscriber, and based upon the stored selection information, selecting one of the first and second service provider information, and outputting the selected service provider information to the mobile unit, free from the other one of the service provider information, based upon the step of selecting. See col. 6, line 66 through col. 7, line 12.

Regarding claim 84, Watters discloses all of the limitations of claim 82, and also discloses that output information regarding a plurality of the candidate service providers is provided to the mobile unit, and the output information is provided based on prioritization information, and the information is based on service preference information (e.g., a specific ethnic type of restaurant). See col. 6, line 66 through col. 7, line 12.

Regarding claim 85, Watters discloses all of the limitations of claim 82, and also discloses that the method comprises accessing stored subscriber defined prioritization

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criterion information (e.g., a specific ethnic type of restaurant). See col. 6, line 66 through col. 7, line 12.

Regarding claim 86, Watters discloses all of the limitations of claim 82, and it is inherent that the selection information is temporarily stored in the network platform when the mobile unit transmits the selection information to the network platform. See col. 6, line 66 through col. 7, line 12.

***Claim Rejections - 35 USC § 103***

4. Claim 83 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watters et al. in view of Brohoff (U.S. Patent No. 6,108,533) and Karmel (U.S. Patent No. 6,353,743).

Regarding claim 82, Watters discloses all of the limitations of claim 82, and also discloses that output information regarding the candidate service providers is provided to the mobile unit, but does not disclose that the output information is provided based on prioritization information relative to a priority for presenting the information to a subscriber, or that the prioritization information relates to establishing the priority based on proximity of particular service providers to the mobile unit.

Brohoff discloses a method for providing location based services in a wireless network which comprises providing output information regarding a plurality of candidate service providers to a mobile unit, based on prioritization information relative to a priority for presenting the information to a subscriber. The prioritization information relates to establishing the priority based on proximity of particular service providers to the mobile

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unit. This allows for the presentation of the service provider information to the user of the mobile unit in a way that is convenient to the user. See col. 6, lines 28-63. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Watters with Brohoff, such that the output information is provided based on prioritization information relative to a priority for presenting the information to a subscriber, and the prioritization information relates to establishing the priority based on proximity of particular service providers to the mobile unit, in order to provide a convenient presentation of the service provider information to the user of the mobile unit.

Brohoff does not disclose that the priority is established by providing the location information in a form suitable for distance determinations, determining a first distance between the mobile unit and the first service provider, determining a second distance between the mobile unit and the second service provider, performing a comparison of the first and second distance, and determining a presentation of the output information based upon the comparison. However, Karmel teaches determining distances between a mobile unit and candidate service providers. See col. 5, line 63 through col. 6, line 21. One of ordinary skill in the art at the time of the invention would have appreciated that determining an actual distance between the mobile unit and a service provider is a much better indication of proximity than the zone technique used by Brohoff. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combination of Watters and Brohoff with Karmel, such that the priority is established by providing the location information in a form suitable for distance determinations, determining a first distance between the mobile unit and the first service

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provider, determining a second distance between the mobile unit and the second service provider, performing a comparison of the first and second distance, and determining a presentation of the output information based upon the comparison, in order to provide a more accurate indication of proximity to the candidate service providers.

5. Claim 87 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watters et al. in view of Bolduc et al. (U.S. Patent No. 6,157,841).

Regarding claim 87, Watters discloses an apparatus for providing location based services in a wireless network. The apparatus comprises a network platform (location server/location service server) in selective communication with a wireless subscriber using a mobile unit via an air interface, and a first interface (a BTS), associated with the network platform, for receiving a service request requesting service provider information regarding the location based services. See col. 2, lines 32-53 and col. 3, lines 34-37. The service request includes service type information identifying a type of services for which the service provider information is requested. See col. 3, lines 40-42. The apparatus also comprises a second interface (a BTS), associated with the network platform, for obtaining location information regarding a location of the mobile unit determined using a network assisted location finding technology. The technology provides location information regarding the mobile unit based in part on a position of the mobile unit in relation to a known location of a stationary ground based network device (base station) in communication with the mobile unit. See col. 1, lines 40-46 and col. 3,

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lines 42-45. The apparatus also comprises first logic, associated with the network platform, for identifying multiple service providers and multiple associated items of service provider information based on the service type information and the location information. See col. 3, lines 49-55. The apparatus also comprises a third interface for outputting some of the items of service provider information to the mobile unit. See col. 6, line 66 through col. 7, line 12.

Watters does not disclose that the apparatus comprises second logic, associated with the network platform, for accessing stored presentation information relating to specific ones of the multiple service providers for use in establishing a priority independent of proximity for presentation of at least some of the items of service provider information to the mobile unit, or that the service provider information is outputted in accordance with the priority. However, Bolduc discloses an apparatus for providing location based services in a wireless network which comprises logic, associated with a network platform, for accessing stored presentation information relating to specific service providers for use in establishing a priority independent of proximity for presentation of items of service provider information to a mobile unit. See col. 4, lines 30-33. This allows the service provider information to be presented to a user based on his stored preferences. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Watters with Bolduc, such that the apparatus comprises second logic, associated with the network platform, for accessing stored presentation information relating to specific ones of the multiple service providers for use in establishing a priority independent of proximity for presentation of at least



some of the items of service provider information to the mobile unit, and the service provider information is outputted in accordance with the priority, in order to allow the service provider information to be presented to user in accordance with his preferences.

***Allowable Subject Matter***

6. Claims 76-81 are allowed.

7. The following is a statement of reasons for the indication of allowable subject matter:

The present invention is directed to a method for providing location based services in a wireless network. The method comprises: receiving, on a network platform in communication with a subscriber using a mobile unit via an air interface, a service request requesting service provider information regarding the location based services; obtaining, on the network platform, location information regarding a location of the mobile unit determined using a network assisted location finding technology; identifying, on the network platform, first and second service providers and associated first and second service provider information based upon the service type information and the determined location of the mobile unit; accessing stored subscriber independent prioritization information relating to a prioritization for presenting service provider information to a subscriber; based upon the stored prioritization information, prioritizing the first and second service provider information; and outputting both the first and second service information on the mobile unit based upon the step of prioritizing.

Claim 76 identifies the uniquely distinct feature "said stored prioritization information establishing a basis independent of proximity and independent of any subscriber preferences for prioritizing said first and second service provider information."

The closest prior art, Brohoff, discloses a method for providing location based services in a wireless network. The method comprises: receiving, on a network platform in communication with a subscriber using a mobile unit via an air interface, a service request requesting service provider information regarding the location based services; obtaining, on the network platform, location information regarding a location of the mobile unit determined using a network assisted location finding technology; identifying, on the network platform, first and second service providers and associated first and second service provider information based upon the service type information and the determined location of the mobile unit; accessing stored subscriber independent prioritization information relating to a prioritization for presenting service provider information to a subscriber; based upon the stored prioritization information, prioritizing the first and second service provider information; and outputting both the first and second service information on the mobile unit based upon the step of prioritizing. However, Brohoff fails to anticipate or render the above underlined limitations obvious.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ken Moore, whose telephone number is (703) 308-6042. The examiner can normally be reached on Monday-Friday from 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold, can be reached at (703) 305-4379.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 872-9314 (for Technology Center 2600 only)

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Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

Ken Moore

1/10/04

*JKM*

*Charles Appiah*  
**CHARLES APPIAH**  
**PRIMARY EXAMINER**